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Filing date: **12/04/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

### Petitioner Information

Name	Board of Regents of the University System of Georgia		
Entity	Body politic of the State of GA	Citizenship	Georgia
Address	270 Washington Street, S.W. Atlanta, GA 30334 UNITED STATES		

Attorney information	Anthony B. Askew Meunier Carlin & Curfman, LLC 817 W. Peachtree Street, N.W. Suite 500 Atlanta, GA 30308 UNITED STATES taskew@mcciplaw.com, sschaetzel@mcciplaw.com, tlevie@mcciplaw.com, rgentry@mcciplaw.com, mcogburn@mcciplaw.com Phone:404-645-7700
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### Registrations Subject to Cancellation

Registration No	1682259	Registration date	04/07/1992
Registrant	REGENT UNIVERSITY 1000 Regent University Drive Virginia Beach, VA 234649800 UNITED STATES		

### Goods/Services Subject to Cancellation

Class 041. First Use: 1990/01/01 First Use In Commerce: 1990/01/01  
All goods and services in the class are cancelled, namely: educational services; namely, providing courses of study at the university level

### Grounds for Cancellation

Genericness	Trademark Act section 23		
Registration No	3460434	Registration date	07/08/2008
Registrant	Regent University 1000 Regent University Drive Virginia Beach, VA 234649800 UNITED STATES		

### Goods/Services Subject to Cancellation

Class 041. First Use: 1990/01/00 First Use In Commerce: 1990/01/00  
All goods and services in the class are cancelled, namely: Educational services, namely, providing courses of instruction at the university level

## Grounds for Cancellation

Genericness		Trademark Act section 23	
Registration No	3465808	Registration date	07/15/2008
Registrant	Regent University 1000 Regent University Drive Virginia Beach, VA 234649800 UNITED STATES		

## Goods/Services Subject to Cancellation

Class 041. First Use: 2007/05/01 First Use In Commerce: 2007/05/01  
All goods and services in the class are cancelled, namely: Educational services, namely, providing courses of instruction at the university level and distribution of course material in connection therewith

## Grounds for Cancellation

Genericness	Trademark Act section 23
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Attachments	10166-266CAN_Petition_to_Cancel_with_Exhibits.pdf ( 18 pages )(247745 bytes )
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## Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by Overnight Courier on this date.

Signature	/Anthony B. Askew/
Name	Anthony B. Askew
Date	12/04/2012

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Trademark Registration No. 1,682,259  
For the mark: REGENT UNIVERSITY & Design  
Date registered: April 7, 1992

In the matter of Trademark Registration No. 3,460,434  
For the mark: REGENT UNIVERSITY  
Date registered: July 8, 2008

In the matter of Trademark Registration No. 3,465,808  
For the mark: REGENT UNIVERSITY & Design  
Date registered: July 15, 2008

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:  
BOARD OF REGENTS OF THE UNIVERSITY :  
SYSTEM OF GEORGIA, :  
:  
Petitioner, : Cancellation No. \_\_\_\_\_  
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v. :  
:  
REGENT UNIVERSITY, :  
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Registrant. :  
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PETITION TO CANCEL

Petitioner Board of Regents of the University System of Georgia believes that it is being and will be damaged by U.S. Trademark Registration No. 1,682,259 for the trademark REGENT UNIVERSITY & Design, registered on April 7, 1992 by Regent University; U.S. Trademark Registration No. 3,460,434 for the trademark REGENT UNIVERSITY, registered on July 8, 2008 by Regent University; and U.S. Trademark Registration No. 3,465,808 for the trademark REGENT UNIVERSITY & Design, registered on July 15, 2008 by Regent University, and Petitioner hereby requests that said registrations be cancelled.

1.

To the best of the Petitioner's knowledge, the name and address of the current owner of the registrations-at-issue is:

Regent University  
1000 Regent University Drive  
Virginia Beach, Virginia 23464-9800

The grounds for cancellation are as follows:

**THE PARTIES**

2.

Petitioner Board of Regents of the University System of Georgia ("Board of Regents") is a body politic of the State of Georgia.

3.

Registrant Regent University, on information and belief, is a corporation organized and existing under the laws of the Commonwealth of Virginia, having a principal place of business at 1000 Regent University Drive, Virginia Beach, Virginia 23464.

4.

On information and belief, Regent University is the owner of U.S. Trademark Registration No. 1,682,259 for the mark REGENT UNIVERSITY & Design. A copy of U.S. Registration No. 1,682,259 is provided as Exhibit A to this Petition to Cancel.

5.

On information and belief, Regent University is the owner of U.S. Trademark Registration No. 3,460,434 for the mark REGENT UNIVERSITY. A copy of U.S. Registration No. 3,460,434 is provided as Exhibit B to this Petition to Cancel.

6.

On information and belief, Regent University is the owner of U.S. Trademark Registration No. 3,465,808 for the mark REGENT UNIVERSITY & Design. A copy of U.S. Registration No. 3,465,808 is provided as Exhibit C to this Petition to Cancel.

### **STATEMENT OF FACTS**

7.

Petitioner Board of Regents was created in 1931 and is an agency of the State of Georgia vested with the governance, control, and management of the University System of Georgia.

8.

Petitioner Board of Regents acts as the governing body for the public higher educational institutions of Georgia.

9.

Petitioner Board of Regents oversees the colleges and universities that comprise the University System of Georgia, Skidway Institute of Oceanography, and The Georgia Public Library System.

10.

Petitioner Board of Regents is currently composed of eighteen members appointed by the Governor of Georgia and confirmed by the Georgia State Senate.

11.

Since its creation in 1931, Petitioner Board of Regents has continuously used the marks BOARD OF REGENTS and REGENTS to refer to the agency and the educational services and associated goods provided by the Petitioner Board of Regents.

12.

On information and belief, on November 5, 1990, Regent University filed Application Serial No. 74/112,380 to register the mark REGENT UNIVERSITY & Design claiming a date of first use in interstate commerce of January 1, 1990. The services identified in Application Serial No. 74/112,380 were “educational services, namely, providing courses of study at the university level.”

13.

Application Serial No. 74/112,380 matured into U.S. Trademark Registration No. 1,682,259, which issued to Registrant Regent University on April 7, 1992. The services identified in U.S. Trademark Registration No. 1,682,259 are “educational services; namely, providing courses of study at the university level.” The stated date of first use and first use in commerce is January 1, 1990.

14.

On information and belief, on May 1, 2007, Regent University filed Application Serial No. 77/170,134 to register the mark REGENT UNIVERSITY claiming a date of first use in interstate commerce of January 1990. The services identified in Application Serial No. 77/170,134 were “educational services, namely, providing courses of instruction at the university level.”

15.

Application Serial No. 77/170,134 matured into U.S. Trademark Registration No. 3,460,434, which issued to Registrant Regent University on July 8, 2008. The services identified in U.S. Trademark Registration No. 3,460,434 are “educational services, namely, providing courses of instruction at the university level.” The stated date of first use and first use in commerce is January 1990.

16.

On information and belief, on June 12, 2007, Regent University filed Application Serial No. 77/204,144 to register the mark REGENT UNIVERSITY & Design claiming a date of first use in interstate commerce of May 1, 2007. The services identified in Application Serial No. 77/204,144 were “educational services, namely, providing courses of instruction at the university level and distribution of course material in connection therewith.”

17.

Application Serial No. 77/204,144 matured into U.S. Trademark Registration No. 3,465,808, which issued to Registrant Regent University on July 15, 2008. The services identified in U.S. Trademark Registration No. 3,465,808 are “educational services, namely, providing courses of instruction at the university level and distribution of course material in connection therewith.” The stated date of first use and first use in commerce is May 1, 2007.

18.

On information and belief, Registrant Regent University uses the marks REGENT UNIVERSITY & Design and REGENT UNIVERSITY as shown in U.S. Trademark Registration Nos. 1,682,259; 3,460,434; and 3,465,808 for providing educational services at the university level.

19.

During the prosecution of Application Serial Nos. 77/170,134 and 77/204,144, the applications were suspended pending the resolution of previously-filed Application Serial No. 77/015,602 for “Regentstutor” as used for educational services, namely conducting distance learning instruction at the secondary, college and graduate levels.

20.

During prosecution of the cited Application Serial No. 77/015,602 for “Regentstutor,” registration was refused because “the proposed mark appears to be generic in connection with the identified services . . . .”

21.

The “Regentstutor” application was then abandoned by the applicant and the suspension of Application Serial Nos. 77/170,134 and 77/204,144 was lifted and those applications, being processed by a different trademark examiner, then proceeded to registrations.

22.

Petitioner Board of Regents has standing to pursue this proceeding.

**“REGENT” IS A GENERIC TERM**

23.

U.S. Trademark Registration Nos. 3,460,434 and 3,465,808 are not incontestable.

24.

U.S. Trademark Registration No. 1,682,259 is not incontestable pursuant to 15 U.S.C. §§ 1052, 1064(3), and 1065(4).

25.

A registered mark, whether incontestable or not incontestable, is subject to cancellation at any time if the purported mark becomes or is shown to be a generic term.

26.

According to *Merriam-Webster Dictionary*, the word “regent” is defined, *inter alia*, as: “a member of a governing board (as of a state university).” See <http://www.merriam-webster.com/dictionary/regent>.



27.

According to *The American Heritage Dictionary of the English Language*, the word “regent” is defined, *inter alia*, as: “A member of a board that governs an institution, such as a state university.” See <http://www.ahdictionary.com/word/search.html?q=regent>.

28.

According to *Oxford Dictionaries*, the word “regent” is defined, *inter alia*, as: “a member of the governing body of a university or other academic institution.” See [http://oxforddictionaries.com/definition/american\\_english/regent?region=us&q=regent](http://oxforddictionaries.com/definition/american_english/regent?region=us&q=regent).

29.

The term “regent” has been and continues to be used generically by members of the public, universities, colleges, and others in the provision of educational services.

30.

Traditional and online media sources use the term “regent” or “regents” in connection with the provision of educational services. Such sources include, but are not limited to, THE WALL STREET JOURNAL, THE NEW YORK TIMES, LOS ANGELES TIME, and SACRAMENTO BEE:

- “Cooper Union will also start new programs as soon as 2013, like a master’s degree program combining the school’s strengths in technology and design, or online programs, to increase both enrollment and revenue. Dr. Bharucha acknowledged that the plan called for ‘a very accelerated time scale,’ adding that the college was already in discussions with the State Board of **Regents**, which must authorize any new programs.” *Cooper Union Will Charge Tuition for Graduate Students*, THE NEW YORK TIMES, April 25, 2012, A18 (emphasis added).
- “The Arizona Board of **Regents** met with student leaders from all three universities Wednesday to discuss the future of the \$2 fee students pay to the Arizona Students’ Association every semester. Rick Myers, chair of the Board of **Regents**, said a large number of students raised concerns over the fee and ASA, putting the issue on the board’s radar. ‘For many years the **regents** weren’t looking at this, and it wasn’t being judged in any way,’ Myers said. ‘The fact that ASU students took this action prompted the **regents** to take a step back and say ‘what’s going on’ and reassess the situation.’” *Arizona Board of Regents holds meeting to discuss statewide students’*

*association fee*, DOWNTOWN DEVIL, November 8, 2012, available at <http://downtowndevil.com/2012/11/08/34433/arizona-students-association-fee/> (emphasis added).

- “It was an early hint of the changes afoot at the U.T. board and the tense months -- some of the most tumultuous in institutional memory, with the **regents** seemingly pitted against the flagship university in a highly public spat -- that lay ahead. Of that new crop of board members, none have received more scrutiny than Alex Cranberg.” *A Lightning Rod on U.T. Board, Regent Is Not Deterred*, THE NEW YORK TIMES, June 12, 2011, A35 (emphasis added).
- “**Regent** 8 reflects collaboration with some of the largest, most technologically advanced schools in the country to identify evolving business requirements. The early adoption of **Regent** 8 has been overwhelming, with 16 schools representing 43 campuses and over 230,000 students currently implementing the solution.” *Regent Education introduces Regent 8*, SACRAMENTO BEE, November 1, 2012, available at <http://www.sacbee.com/2012/11/01/4955611/regent-education-introduces-regent.html> (emphasis added).
- “But fewer out-of-state than in-state students typically accept their UC offers. Officials said they expect the systemwide enrollment of non-California freshmen this fall to end up below 10%, the maximum set by the UC **regents** in December when they moved to boost the proportion of such students from 6% now. Out-of-state students pay \$23,000 more annually than in-state students, money the cash-strapped system says it needs.” *UC is reaching out of state; the number of non-Californians offered admission is up substantially*, LOS ANGELES TIMES, April 19, 2011, AA1 (emphasis added).
- “At its monthly meeting on Monday, the **Regents** considered ways to encourage more school districts to work together. On the table are plans to increase aid and create financial penalties for districts recommended for reorganization that do not choose to do so.” *Regents consider increasing mergers*, timesunion.com, November 5, 2012, available at <http://www.timesunion.com/local/article/Regents-consider-increasing-mergers-4010878.php> (emphasis added).
- “Those mobilizing to oppose cutbacks and tuition increases at public universities continue to misdirect their anger toward administrators and **regents** rather than toward state and national politicians. Although activists are right to point out that administrators and board members at some public institutions are sitting on large endowments, a substantial portion - about 70 percent at the University of Virginia - of those funds is restricted to specific purposes. Using endowment money to prevent tuition hikes or academic cutbacks is not a long-term solution.” *University budget woes require government action – and educational reforms*, THE WASHINGTON POST, December 31, 2011, A14 (emphasis added).

- “Just five days from the election, about 16 students gathered at Barrows Hall Thursday evening to hear a presentation by the UC student **regents** about the effects of Proposition 30, a ballot measure that could prevent a 20 percent tuition hike in January, on the UC’s budget. At the presentation, Jonathan Stein, the student **regent**, and Cinthia Flores, the student **regent**-designate, emphasized the importance of students voting in the upcoming election to prevent \$250 million in midyear budget cuts to the UC.” *Student Regents Hold Prop. 30 and Budget Presentation*, THE DAILY CALIFORNIAN, November 5, 2012, available at <http://www.dailycal.org/2012/11/05/student-regents-hold-prop-30-and-budget-presentation/> (emphasis added).
- “Churchill’s attorney, David Lane, said he will appeal to the Colorado Court of Appeals. Lane said the judge’s ruling means the **regents** could fire Churchill if they don’t like what he says, or even because of his race or religion. ‘This judge says that’s OK,’ Lane said. ‘If your 1st Amendment rights are violated by the state of Colorado, don’t look for justice in Denver District Court.’ University President Bruce Benson issued a statement saying the judge had ‘appropriately applied the law. This ruling recognizes that the **regents** have to make important and difficult decisions. The threat of litigation should not be used to influence those decisions,’ he said.” *Professor fired after 9/11 essay loses bid to regain job*, CHICAGO TRIBUNE, July 8, 2009, C34 (emphasis added).
- “As **regent**, Heidemann said he hopes to keep the state’s attention on agriculture. ‘Where I’m from and what I do, (agriculture) is where I see my little niche,’ he said. ‘The university does a great job of focusing on agriculture, and I want to make sure that focus stays there.’” *Nebraska State Sen. Lavon Heidemann takes position on NU Board of Regents*, thedailynebraskan.com, November 11, 2012, available at [http://www.dailynbraskan.com/news/article\\_dd45bbec-2c79-11e2-8e0d-0019bb30f31a.html](http://www.dailynbraskan.com/news/article_dd45bbec-2c79-11e2-8e0d-0019bb30f31a.html) (emphasis added).
- “The board of **regents** rejected that proposed increase this month, citing the difficult economic climate for students and their families. ‘The trend of consistently raising tuition to counter reductions from other funding sources is not sustainable for students and parents,’ Mr. Cigarroa said in a statement Wednesday. However, the **regents** did agree to raise tuition for undergrads from out of state, who will pay more than \$33,000 next year, on average, or a 2% increase.” *U.S. News: Dispute Over College Tuition Roils Flagship Texas Campus*, THE WALL STREET JOURNAL, May 18, 2012, A2 (emphasis added).

31.

In addition to Petitioner Board of Regents, many other governing bodies or agencies also use the term “regent” or “regents” in association with educational services and providing courses of study at the university level such as, for example, The Regents of the University of California;

Regents of the University of Michigan; Kansas Board of Regents; South Dakota Board of Regents; Board of Regents of the University of Nebraska; University of Texas System Board of Regents; University of Colorado Board of Regents; and Board of Regents for the State of Louisiana, among others.

32.

It is common in the educational environment for the term “regent” to be used generically to identify a member of Board of Regents.

33.

Other educational institutions in the United States use the term “regent” or “regents” in association with educational services, such as, for example, Regents School of Austin. *See generally* <http://www.regents-austin.com/>.

34.

The USPTO determined in Application Serial No. 77/015,602 that the proposed mark for registration “Regentstutor” appeared to be generic when used in connection with educational services, namely conducting distance learning instruction at the secondary, college, and graduate level.

35.

The term “regent” is generic to the relevant public and has not gained any other significance beyond the provision of educational services.

36.

Registrant’s marks are generic and the registrations for those marks may be cancelled pursuant to 15 U.S.C. § 1064(3).

37.

Alternatively, on information and belief, assuming only for purposes of the single allegation that Registrant for a time had a protectable interest in and to the purported marks REGENT UNIVERSITY and/or REGENT UNIVERSITY & Design, Registrant has, on information and belief, abandoned any such enforceable right in the purported marks through failure to police such purported marks; failure to appropriately control the nature and quality of the products and services provided in association with the marks; or by “naked licensing” practices, such that the purported marks have lost significance as source indicators to the relevant public, resulting in an abandonment thereof.

WHEREFORE, Petitioner Board of Regents is being damaged and will continue to be damaged by U.S. Trademark Registration Nos. 1,682,259; 3,460,434; and 3,465,808, and prays that said registrations be, in their entirety, cancelled.

Transmitted herewith by Electronic Funds Transfer in the amount of \$900.00 are the fees for filing this PETITION TO CANCEL. No additional fees are believed to be due; however, the Commissioner is hereby authorized to charge any additional fees that may be required, or credit any overpayment, to Deposit Account No. 50-5226.

MEUNIER CARLIN & CURFMAN, LLC

Attorneys for Petitioner  
Board of Regents of the  
University System of Georgia

Dated: December 4, 2012  
Atlanta, Georgia

By: /Anthony B. Askew/  
Anthony B. Askew  
Stephen M. Schaetzel  
Robin L. Gentry  
Walter Hill Levie, III

817 W. Peachtree Street  
Suite 500  
Atlanta, Georgia 30308  
(404) 645-7700

**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing **PETITION TO CANCEL** has been served this day upon Registrant and Registrant's Domestic Representative by mailing said copy, via first class mail, postage prepaid, and overnight delivery, to:

Regent University  
1000 Regent University Drive  
Virginia Beach, Virginia 23464-9800

Patrick J. Arnold  
McAndrews, Held & Malloy Ltd.  
34<sup>th</sup> Floor  
500 West Madison Street  
Kansas City, MO 64112

Dated: December 4, 2012

/Anthony B. Askew/  
Anthony B. Askew

**CERTIFICATE OF FILING**

I hereby certify that this document is being electronically filed with the United States Patent and Trademark Office on December 4, 2012.

/Anthony B. Askew/  
Anthony B. Askew

# **EXHIBIT A**

Int. Cl.: 41

Prior U.S. Cl.: 107

**United States Patent and Trademark Office**

**Reg. No. 1,682,259**

Registered Apr. 7, 1992

**SERVICE MARK  
PRINCIPAL REGISTER**



REGENT UNIVERSITY (VIRGINIA NON-  
STOCK CORPORATION)  
VIRGINIA BEACH, VA 234649800

FOR: EDUCATIONAL SERVICES; NAMELY,  
PROVIDING COURSES OF STUDY AT THE  
UNIVERSITY LEVEL, IN CLASS 41 (U.S. CL.  
107).

FIRST USE 1-1-1990; IN COMMERCE  
1-1-1990.

NO CLAIM IS MADE TO THE EXCLUSIVE  
RIGHT TO USE "UNIVERSITY", APART FROM  
THE MARK AS SHOWN.

SER. NO. 74-112,380, FILED 11-5-1990.

LIZ KULICK, EXAMINING ATTORNEY



# **EXHIBIT B**

Int. Cl.: 41

Prior U.S. Cls.: 100, 101 and 107

United States Patent and Trademark Office

Reg. No. 3,460,434

Registered July 8, 2008

SERVICE MARK  
PRINCIPAL REGISTER

Regent University

REGENT UNIVERSITY (VIRGINIA CORPORATION)  
1000 REGENT UNIVERSITY DRIVE  
VIRGINIA BEACH, VA 234649800

OWNER OF U.S. REG. NOS. 1,682,259 AND  
3,111,799.

FOR: EDUCATIONAL SERVICES, NAMELY,  
PROVIDING COURSES OF INSTRUCTION AT  
THE UNIVERSITY LEVEL, IN CLASS 41 (U.S. CLS.  
100, 101 AND 107).

NO CLAIM IS MADE TO THE EXCLUSIVE  
RIGHT TO USE "UNIVERSITY", APART FROM  
THE MARK AS SHOWN.

FIRST USE 1-0-1990; IN COMMERCE 1-0-1990.

SER. NO. 77-170,134, FILED 5-1-2007.

THE MARK CONSISTS OF STANDARD CHAR-  
ACTERS WITHOUT CLAIM TO ANY PARTICULAR  
FONT, STYLE, SIZE, OR COLOR.

MICHELLE DUBOIS, EXAMINING ATTORNEY

# **EXHIBIT C**

Int. Cl.: 41

Prior U.S. Cls.: 100, 101 and 107

United States Patent and Trademark Office

Reg. No. 3,465,808

Registered July 15, 2008

**SERVICE MARK  
PRINCIPAL REGISTER**



REGENT UNIVERSITY (VIRGINIA CORPORATION)  
1000 REGENT UNIVERSITY DRIVE  
VIRGINIA BEACH, VA 234649800

NO CLAIM IS MADE TO THE EXCLUSIVE  
RIGHT TO USE "UNIVERSITY", APART FROM  
THE MARK AS SHOWN.

FOR: EDUCATIONAL SERVICES, NAMELY,  
PROVIDING COURSES OF INSTRUCTION AT  
THE UNIVERSITY LEVEL AND DISTRIBUTION  
OF COURSE MATERIAL IN CONNECTION THERE-  
WITH, IN CLASS 41 (U.S. CLS. 100, 101 AND 107).

THE MARK CONSISTS OF A GRAPHIC DEPI-  
TION OF A CROWN FOLLOWED BY THE WORDS  
"REGENT UNIVERSITY".

FIRST USE 5-1-2007; IN COMMERCE 5-1-2007.

SER. NO. 77-204,144, FILED 6-12-2007.

OWNER OF U.S. REG. NOS. 1,682,259 AND  
3,111,799.

MICHELLE DUBOIS, EXAMINING ATTORNEY